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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/782,098	02/19/2004	Carmen Flosbach	FA1224USNA	4752

23906 7590 05/14/2008
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EXAMINER

SERGEANT, RABON A

ART UNIT	PAPER NUMBER
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1796

NOTIFICATION DATE	DELIVERY MODE
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05/14/2008

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/782,098
Filing Date: February 19, 2004
Appellant(s): FLOSBACH ET AL.

Rakesh H. Mehta
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed February 25, 2008 appealing from the Office action mailed July 18, 2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

This appeal involves claims 1, 4, 7, and 10.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

WO 01/25359 A1	Blum et al.	4-2001
US 6,825,241 B1	Blum et al.	11-2004

Since the text of WO 01/25359 is in the German language, US 6,825,241 B1 has been relied upon as an English language equivalent of the WO reference. The US patent was filed as a 35 USC 371 application from PCT/EP00/09625, and the WO reference issued from this PCT application. Accordingly, the disclosures of WO 01/25359 A1 and US 6,825,241 B1 are the same.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Issue I: Rejection of Claims 1, 4, 7, and 10 Under 35 USC 103

Claims 1, 4, 7, and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 01/25359 (US 6,825,241 has been cited as being the English language equivalent of WO 01/25359).

The reference discloses polyurethane diacrylates and powder coatings derived from the polyurethane diacrylates, wherein the polyurethane diacrylates are produced from the reaction of hexane diisocyanate with ethylene glycol, butanediol, and hydroxyethyl acrylate in a molar ratio that meets that claimed, specifically a molar ratio that corresponds to appellants' ratio where the "x" variable equals 2.5. Furthermore, a molar ratio of blended diols is disclosed that meets that claimed, specifically 66.7 mol% ethylene glycol with 33.3 mol% butanediol. See example 5 on page 46 of WO 01/25359 (corresponding to column 21, lines 47-64 of US 6,825,241) and

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examples 3 and 4 on pages 49-51 of WO 01/25359 (corresponding to column 22, line 61 through column 23 of US 6,825,241). Though mixtures of diols are not exemplified that specifically meet those claimed, the reference does disclose the use of other diol species that meet those claimed at page 22, lines 18-25 of WO 01/25359 (corresponding to column 10, lines 56-65 of US 6,825,241). Since the diols of the exemplified blend are included within this listing of diols, this listing essentially establishes the equivalency of the disclosed other diol species to those of the example. Accordingly, it would have been *prima facie* obvious to utilize any of the disclosed diols in the form of blends in the production of the polyurethane diacrylates, in accordance with the teachings of the example.

(10) Response to Argument

Response to Arguments Concerning Issue I

Appellants have argued that their invention yields unexpected results over the prior art and have provided two 37 CFR 1.132 declarations to demonstrate these results. The examiner has considered appellants' declarations as well as the arguments set forth within the appeal brief concerning these showings; however, the position is maintained that the declarations are deficient, because the examples of the declarations are not commensurate in scope with the claims and showings have not been provided relative to the closest teachings of the prior art. The claims encompass fractional values of "x" and molar ratios of the diols that are not exemplified within the declaration. For example, it would seem that the most relevant showings would be where "x" equals 2.5, since the claims encompass such a value and the prior art specifically exemplifies this value; however, no showings have been provided for this value. It has been held that evidence of unexpected results must pertain to the full extent of the subject

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matter claimed. *In re Ackermann*, 170 USPQ 340; *In re Chupp*, 2 USPQ2d 1437, 1440; *In re Murch*, 175 USPQ 89. Accordingly, it has been held that to overcome a reasonable case of *prima facie* obviousness, a given claim must be commensurate in scope with any showing of unexpected results. *In re Greenfield*, 197 USPQ 227. Furthermore, it has been held that a limited showing of criticality is insufficient to support a broadly claimed range. *In re Lemin*, 161 USPQ 288. It is noted that save for the species of diols within Example 5 of the reference, the example is anticipatory in that appellants' claimed diisocyanate and hydroxyacrylate are set forth and specific values within appellants' claimed ranges are set forth. See MPEP 2131.03.

Accordingly, a probative showing should hold these specific values constant with the prior art (i.e.; "x" equals 2.5) while varying only the species of diol; however, such showings have not been provided. While appellants have argued that they have met their burden by providing showings where "x" equals 2 and 3, in view of the exemplified and specific value of "x" of the prior art, the position is taken that appellants' argument fails to satisfy the required legal standard for providing a probative showing. In summation, the position is maintained that appellants' declarations are insufficient to overcome the prior art rejection. Despite appellants' response, the fact remains that showings have not been provided that establish unexpected results relative to the closest teachings of the prior art, i.e.; examples where "x" equals 2.5.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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